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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,725

10/17/2003

Zachary Utz

D-1175 R2

1751

28995

7590

11/15/2006

RALPH E. JOCKE
walker & jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256

EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,725

Applicant(s)

UTZ ET AL.

Examiner

Joseph C. Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8 and 12-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8 and 12-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Final Rejection

Applicant's arguments filed 8/14/2006 have been fully considered but they are not persuasive for reasons detailed below.

The prior art rejections are maintained or modified as follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 12-19, 21-23, 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Imai et al. ("Imai")(US 4,871,162).

Regarding claims 1, 2, 12-19, Imai teaches a method (Fig. 1-6) comprising

a) receiving a stack of financial instrument sheets into a housing of an automated banking machine (Fig. 1);

b) moving a first sheet bounding the stack in a first direction by engaging a first side of the first sheet with at least one sheet engaging portion of at least one picking member, wherein at least one recess extends transversely in the at least one sheet engaging portion (Fig. 2, 3 with recess 5a in picking member 5, 7);

c) engaging a second side of the first sheet opposed of the first side with a plurality of first stripping portions, wherein during engagement with the second side the at least one first stripping portion is operative to provide resistance to movement of the

Art Unit: 3653

first sheet in the first direction, wherein the at least one first stripping portion is generally aligned with the at least one recess (Fig. 2 first stripping portions 18; col. 3, ln. 27-col. 4, ln. 33);

d) engaging the second side of the first sheet with at least one second stripping portion, wherein during engagement with the second side the at least one second stripping portion is operative to provide resistance to movement of the first sheet in the first direction, wherein the at least one second stripping portion is nonaligned with the at least one recess (Fig. 2 second stripping portions 12 or 13a with 13a in biased abutting contact with roller; col. 3, ln. 27-col. 4, ln. 33 describing sheet being fed by first stripping portion before coming into contact with second stripping portions);

e) separating the first sheet from the stack by movement of the first sheet in the first direction while in engagement with each of the at least one sheet engaging portion, at least one first stripping portion and at least one second stripping portion (col. 3, ln. 27-col. 4, ln. 33 describing sheet being fed by first stripping portion before coming into contact with second stripping portions),

wherein the device operates by rotating the generally cylindrical picking member in a second rotational direction opposite of the first rotational direction; rotating the at least one first and at least one second roll surfaces in cooperating relation with the picking member rotating in the second rotational direction to facilitate moving a sheet therebetween in a second direction opposed of the first direction (Id., Fig. 3-6).

Regarding method claims 21-23, 28-31, these steps occur during the operation of the device as cited above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-8 and 12-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beskitt et al. ("Beskitt")(US 6,302,393) in view of Imai et al. ("Imai")(US 4,871,162).

Beskitt teaches an ATM device (Fig. 1) comprising a stack (32, 34), user interface (col. 4, ln. 58-col. 5, ln. 23), and a note denominator and validator (col. 1, ln. 8-67; col. 6, ln. 21-col. 11, ln. 65 teaching ATM machine that dispenses currency and accepts deposits to a stacking area as well as sorting to variety of stackers and storage areas based on a characteristic).

Beskitt as set forth above thus teaches all that is claimed except for expressly teaching sheet engaging and feeding steps claimed by Applicant. Imai, however, as cited above expressly teaches the engaging and feeding steps. Moreover, Imai teaches that this type of feeder is better at singling notes than the prior art cash handlers (col. 1, ln. 20-48). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Beskitt with the sheet engager as taught above to obtain a feeding device that is better able to single notes.

Response to Arguments

Applicant's arguments that the prior art fails to teach the amended claimed features are unpersuasive in view of the newly formulated prior art rejections set forth above. Consequently, the claims stand rejected.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584** or to the Supervisory Examiner, Patrick Mackey, **571-272-6916**.

Application/Control Number: 10/688,725
Art Unit: 3653

Page 7

Signed by Examiner Joseph Rodriguez

jcr

November 11, 2006

A handwritten signature in black ink, appearing to be 'JR' followed by a long, sweeping horizontal line that extends towards the right margin of the page.